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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,106	02/11/2004	Eric Bornstein	BORNE40593	2676
7590 02/25/2008				
G. Matthew McCloskey McDermott Will & Emery LLP 28 State Street Boston, MA 02109-1775			EXAMINER SHAY, DAVID M	
			ART UNIT 3735	PAPER NUMBER
			MAIL DATE 02/25/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/776,106

**Applicant(s)**

BORNSTEIN, ERIC

**Examiner**

david shay

**Art Unit**

3735

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on December 4, 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18, 20-35 and 37 is/are pending in the application.
- 4a) Of the above claim(s) 21-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18, 20, 34, 35 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date \_\_\_\_\_
- 6) ☐ Other: \_\_\_\_\_

Applicant argues that the claims are definite, specifically with respect to claims 10 and 20, because the meaning of the term “handle” is clear. Applicant submits that the term in question can mean “a part of a thing made specifically to be grasped by the hand”. While this is noted, the examiner also notes that the handle of a broom, for example is cylindrical. It is further noted that e.g. an optical fiber is also cylindrical and thus must be considered a handle, per se. It is still further noted that lasers for example are also made specifically to be grasped by the hand, else they would be unable to be manipulated or carried from place to place. Given this the existence of a “handle” as defined by applicant is inherent in the device containing a laser or an optical fiber. Given this all the structure required to constitute a “handle” is already recited in claims 1 and 11, and thus claims 10 and 20 are still indefinite.

Applicant then argues that Parker et al is not applicable under section 102 of the statute because “Parker does not teach or suggest the specific narrow wavelength ranges or discrete wavelengths identified and claimed by Applicant”. In view of the specific disclosure of Parker et al at page 8, lines 10-14, wherein the use of the entire range between 800nm and 1100nm sampled at regular intervals, for example intervals of 1.96nm, which would result in application of at least 4 different wavelengths in each of applicant’s two claimed ranges, this argument is not convincing.

With regard to the rejection including the L’Esperance, Jr., applicant argues that since L’Esperance, Jr. does not teach one aspect of the claims (the particular wavelengths). Applicant also argues that the secondary reference to Neuman et al does not teach a different aspect of the claims (emission of two wavelengths). Applicant further argues that Neuman et al teach away from the claimed invention, as they teach avoiding these wavelengths for use in vivo. The

examiner must respectfully note that the teachings of the references must be viewed not in a vacuum, but in the context of the knowledge of one of ordinary skill in the art. Given that L'Esperance, Jr. clearly teaches using a variety of wavelengths over a large range to provide sterilization of tissue. It is well settled that "A person of ordinary skill is also a person of ordinary creativity, not an automaton." *KSR International Co. v Teleflex Inc.* 82 USPQ2d 1385, 1397 (Supreme Court, 2007), thus one of ordinary skill in the art, seeking to apply this sterilization method would clearly look for wavelengths that are effective primarily against microbes which would adversely affect the sterility of the site to be sterilized. Thus this argument is not convincing.

With regard to the remaining rejections, applicant merely argues that the additional references do not remedy the defects of the base combination. However, since, as set forth above, the base combination is proper and reads on the claims, these arguments are not convincing.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10 and 20 are indefinite as it appears to fail to further limit the claims from which they depend, as exactly what structure is to be excluded by requiring a handle is unclear, and

since without an optical egress, the delivery of the radiations cannot proceed, and therefore what further limitation is intended to be implied is unclear.

Claims 1, 10, 11, 20, 34, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al in combination with Rao et al. Parker et al teach applying multiple wavelengths to the body by separate channels at numerous wavelengths in each of applicant's claimed ranges. Rao et al teach production of a wavelength range encompassing the entirety of applicant's wavelength range with a titanium sapphire laser. It would have been obvious to the artisan of ordinary skill to employ the laser of Rao et al in the device of Parker et al, since this would produce the desired wavelengths at precisely controllable wavelength, power, and intensity values, thereby enabling more accurate measurement, thus producing a device such as claimed.

Claims 1-4, 10-14, 20, 34, 35, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over L'Esperance, Jr. in combination with Neuman et al. L'Esperance, Jr. teaches a device for sterilizing a site wherein two laser beams are projected onto the area to be sterilized. Neuman et al teach that bacteria are destroyed by wavelengths at 830 nm and 970 nm. It would have been obvious to the artisan or ordinary skill to employ lasers producing the wavelengths of Neuman et al in the device of L'Esperance, Jr., since these wavelengths are effective for killing bacteria, as taught by Neuman et al, thus producing a device such as claimed.

Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over L'Esperance, Jr. in combination with Neuman et al as applied to claims 1-4, 9-14, 19, 20, and 34-42, and further in combination with Harris. Harris teaches a device for sterilizing a site including a scaler. It would have been obvious to the artisan or ordinary skill to employ the laser

device of the combined teachings of Neuman et al and L'Esperance, Jr. in the device of Harris, since these wavelengths are effective for killing bacteria, as taught by Neuman et al and the combination of multiple wavelengths provides improved results, as taught by nL'Esperance, Jr., or, alternatively, to include the scaler of Harris in the combined device of L'Esperance, Jr. and Neuman et al, since L'Esperance does not limit the application of the device to any particular tissue, thus producing a device such as claimed.

Claims 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over L'Esperance, Jr. in combination with Neuman et al and Harris as applied to claims 5 and 15, and further in combination with Pathak et al. Pathak et al teach that providing a forsted fiber end allows radial distribution of the radiation. It would have been obvious to the artisan or ordinary skill to employ the frosted fiber end of Pathak et al device of the combined teachings of Neuman et al, Harris, and L'Esperance, Jr., since this would distribute the radiation radially, enabling the sterilization of the length of the gingival pocket all at once, thus yielding a quicker procedure, thus producing a device such as claimed.

Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over L'Esperance, Jr. in combination with Neuman et al as applied to claims 1-4, 9-14, 19, 20, and 34-42, and further in combination with Schechter et al. Schechter et al teach the use of a laser otoscope to perform surgery. It would have been obvious to the artisan or ordinary skill to employ the combined device of Neuman et al and L'Esperance, Jr. in the device of Schechter et al, since the device is intended to be used to disinfect the tissue surface before surgery, as taught by L'Esperance, Jr., thus producing a device such as claimed.

Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over L'Esperance, Jr. in combination with Neuman et al as applied to claims 1-4, 9-14, 19, 20, and 34-42, and further in combination with Prescott. Prescott teaches the application of therapeutic light to toe ulcers of diabetics. It would have been obvious to the artisan or ordinary skill to employ the combined device of Neuman et al and L'Esperance, Jr. in the device of Prescott, since this would also prevent the ulcers from getting infected, which is desirable, and to use a digit clip to retain the light emitters, since this is not critical; is well within the skill of one having ordinary skill in the art; provides no unexpected result; and would allow the light to be applied to the toe without requiring shoes or socks to be worn, thus producing a device such as claimed.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9, 10-18, 29, 34, 35, and 37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent Application No. 11/825,550. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application

anticipate the claims of the instant application. Accordingly, instant application claims are not patentably distinct from the copending application claims. Here, the copending application claims require elements A, B, C, and D while instant application claims only requires elements A, B, and C. Thus it is apparent that the more specific copending application claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-9, 10-18, 29, 34, 35, and 37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent Application No. 11/841,348. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application anticipate the claims of the instant application. Accordingly, instant application claims are not patentably distinct from the copending application claims. Here, the copending application claims require elements A, B, C, and D while instant application claims only requires elements A, B, and C. Thus it is apparent that the more specific copending application claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.



This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-9, 10-18, 29, 34, 35, and 37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent Application No. 11/981,486. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application anticipate the claims of the instant application. Accordingly, instant application claims are not patentably distinct from the copending application claims. Here, the copending application claims require elements A, B, C, and D while instant application claims only requires elements A, B, and C. Thus it is apparent that the more specific copending application claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-9, 10-18, 29, 34, 35, and 37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-64 of U.S. Patent Application No. 11/997,665. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application anticipate the claims of the instant application. Accordingly, instant application claims are not patentably distinct from the copending application claims. Here, the copending application

claims require elements A, B, C, and D while instant application claims only requires elements A, B, and C. Thus it is apparent that the more specific copending application claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-9, 10-18, 29, 34, 35, and 37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent Application No. 12/019,336. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application anticipate the claims of the instant application. Accordingly, instant application claims are not patentably distinct from the copending application claims. Here, the copending application claims require elements A, B, C, and D while instant application claims only requires elements A, B, and C. Thus it is apparent that the more specific copending application claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments filed December 4, 2007 have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II, can be reached on Monday, Tuesday, Wednesday, Thursday, and Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/david shay/

Primary Examiner, Art Unit 3735